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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,920	02/14/2001	Ieyasu Kobayashi	OHS-104	9687
7590	10/08/2003		EXAMINER	
Rader Fishman & Grauer 1233 20th Street N W Suite 501 Washington, DC 20036			RESAN, STEVAN A	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 10/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/762,920	KOBAYASHI ET AL.	
	Examiner Stevan A. Resan	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,7-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 July 2002 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3, 5-9, 11 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masafumi et al JP 11-144227 for the reasons of record.

4. Claims 1-3, 5, 7-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hosoi et al 5665454 for the reasons of record.

5. Claims 1, 2, 4, 5, 7, 8, 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sakamoto et al 5364684 for the reasons of record.

6. Claims 1 –11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59 127730 (Toray) in view of WO 99 25553 (Teijin '553) for the reasons of record.

7. Claims 3-7, 9-11 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Toray and Teijin as applied above in view of EP 0 893249 (Teijin '249) for the reasons of record.

8. Applicant's arguments filed 7 July 2003 have been fully considered but they are not persuasive.

Applicants argue that the results of the specification and declaration distinguish over the references and therefore the present claims are allowable.

However the examiner points out that claims must be commensurate in scope with the showing of unexpected results and that the showing in the present specification and declaration is based upon superior track dislocation and electromagnetic conversion characteristics of a magnetic recording medium using the film of claim 1 and not characteristics of the biaxially oriented polyester film alone.

Furthermore all of the specification examples use a specific polyester film (i.e. that of claim 7) and the magnetic recording media is made with a substrate that has specific surface roughness characteristics on each side (i.e. Wra and WRz). The conversion characteristics and track dislocation features are dependent upon the roughness features of the media surfaces.

The examiner suggests that applicants amend claim 1 to delete the first line and the second line before "(1)" and insert the following in its place : "A magnetic recording medium comprising a magnetic layer and a biaxially oriented polyethylene-2,6-naphthalene dicarboxylate base film wherein the base film on the magnetic layer side has a center plane average surface roughness Wra of 1-10 nm and a 10 point average surface roughness WRz of 30-250nm and on the side opposite the magnetic layer a center plane average surface roughness Wra of 5-20 nm and a 10 point average surface roughness WRz of 100-300nm, said base film has ". The dependence of claim

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11 should be changed to "1" and Claims 3,4,7-10 should then be cancelled. Claims 1,2,5, and 10 would then be in condition for allowance.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (703) 308-4287. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) *308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718



STEVAN A. RESAN
PRIMARY EXAMINER